

DECLARATION  
FOR UTILITY OR DESIGN  
PATENT APPLICATION

[ ] Declaration Submitted With Initial Filing  
[X] Declaration Submitted After Initial Filing

) Attorney Docket No.: 62891  
) First Named Inventor: Clark, et al.  
) Application Number: 09/326,168  
) Filing Date: 6/4/99  
) Group Art Unit:  
) Examiner Name:

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

PARAMETRIC CONTROL IN PULSED LIGHT STERILIZATION

the specification of which:

[ ] is attached hereto, or

[X] was filed by an authorized person on my behalf on  
June 4, 1999 as United States Application Number  
09/326,168.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, §119(a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT international application which designated at least one country other than the United States of America, listed below, and I have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or any PCT international application, on this invention filed by me or my legal representatives or assigns and having a filing date before that of the application on which priority is claimed:

<u>Prior Foreign Application Number(s)</u>	<u>Country</u>	<u>Foreign Filing Date</u>	<u>Priority Not Claimed</u>	<u>Certified Copy Attached Yes No</u>
N/A				

I hereby claim the benefit under Title 35, United States Code, §119(e) of any United States provisional application(s) listed below:

<u>Provisional Application Number(s)</u>	<u>Provisional Application Filing Date</u>
N/A	

I hereby claim the benefit under Title 35, United States Code, §120, of any prior United States application(s), or under §365(c) of any PCT international application(s) designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT international application(s) in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose all information known by me to be material to patentability as defined in Title 37, Code of Federal Regulations, §1.56, which became available between the filing date of the prior application(s) and the national or PCT international filing date of this application:

<u>Prior U.S. Application Number</u>	<u>Prior PCT International Application Number</u>	<u>Filing Date of U.S. or PCT International Application</u>	<u>Patent Number (if applicable)</u>
08/651,275		5/22/96	5,786,598
08/846,102		6/01/97	Pending

As a named inventor, I hereby appoint the following registered practitioners, with full power of substitution and revocation, to prosecute this application and to transact all business in the United States Patent and Trademark Office connected therewith, and request that all correspondence and telephone calls in respect to this application be directed to FITCH, EVEN, TABIN & FLANNERY, Suite 1600, 120 South LaSalle Street, Chicago, Illinois, 60603, Telephone No. (619) 552-1311, Facsimile No. (619) 552-0095:

109207-TEECOT

<u>Registered</u> <u>Practitioner</u>	<u>Reg.No.</u>	<u>Registered</u> <u>Practitioner</u>	<u>Reg.No.</u>
Morgan L. Fitch, Jr.	17,023	Philip T. Petti	31,651
Francis A. Even	16,880	John Paniaguas	31,051
Julius Tabin	16,754	Donald A. Peterson	18,647
John F. Flannery	19,759	James R. McBride	24,275
Robert B. Jones	20,135	Bruce R. Mansfield	29,086
James J. Schumann	20,856	Richard A. Kaba	30,562
James J. Hamill	19,958	Karl R. Fink	34,161
Timothy E. Levstik	30,192	Thomas F. Lebens	38,221
Joseph E. Shipley	31,137	Marianna S. Hamilton	38,905
Robert J. Fox	27,635	Scott J. Menghini	42,880
Kenneth H. Samples	25,747		

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made herein on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity or enforceability of the application or any patent issued thereon.

Full name of sole or one joint inventor:

Reginald Wayne Clark

(Given names first, with family name last)

Inventor's signature:

Reginald Wayne Clark

Date:

August 16, 1999

Residence:

Del Mar, CA

(City and State for U.S. Residents;  
City and Country for others)

Post Office Address:

12919 Via Esperia

Del Mar, CA 92104

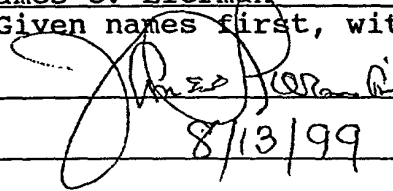
Citizenship:

U.S.

Full name of sole or one  
joint inventor:

James C. Lierman  
(Given names first, with Family name last)

Inventor's signature:



Date:

8/13/99

Residence:

San Diego, CA  
(City and State for U.S. Residents;  
City and Country for others)

Post Office Address:

5376 Renaissance Ave.

San Diego, CA 92122

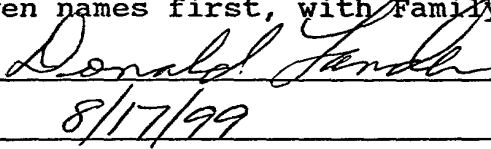
Citizenship:

U.S.

Full name of sole or one  
joint inventor:

Donald Lander  
(Given names first, with Family name last)

Inventor's signature:



Date:

8/17/99

Residence:

La Jolla, CA  
(City and State for U.S. Residents;  
City and Country for others)

Post Office Address:

5848 Soledad Road

La Jolla, CA 92037

Citizenship:

U.S.

10039341.102501  
T0920T TEE500T

Full name of sole or one  
joint inventor:

Joseph E. Dunn  
(Given names first, with Family name last)

Inventor's signature:

Date:

Residence:

Crystal Lake, IL  
(City and State for U.S. Residents;  
City and Country for others)

Post Office Address:

7108 Red Barn Road

Crystal Lake, IL 60012

Citizenship:

U.S.

Address for correspondence:

FITCH, EVEN, TABIN & FLANNERY  
120 South LaSalle Street-Suite 1600  
Chicago, Illinois 60603-4277

1003931 102601  
109201 TFE6E00F

INVENTION AND SECRECY AGREEMENT

This is an Agreement between MAXWELL LABORATORIES, INC.,  
a California corporation, hereinafter called "MAXWELL" and  
JOSEPH DUNN hereinafter  
called "EMPLOYEE."

1. EMPLOYEE, in consideration of his employment by  
MAXWELL, agrees as follows:

(a) That he will hold in strictest confidence and  
not disclose to any person, firm or corporation, without the  
express written authorization of an officer of MAXWELL, any  
information, manufacturing technique, process, formula, develop-  
ment or experimental work, work in process, business trade  
secret or any other secret or confidential matter relating to  
the products, sales, business or activity of MAXWELL, except as  
such disclosure or use may be required in connection with  
EMPLOYEE'S work for MAXWELL.

(b) That he will recognize as binding on him and  
comply with government-prescribed regulations and mandatory  
contract provisions relating to the safeguarding of military  
information and transferring or making available to the  
Government of such patent rights as may be the subject of  
contracts between MAXWELL and the Government of the United  
States of America or any of its agencies.

10039311-102601

(c) That he will disclose promptly to MAXWELL all inventions, discoveries, improvements, trade secrets and secret processes, related to or useful in the business of MAXWELL, whether patentable or not, made or conceived by EMPLOYEE, either solely or in collaboration with others, during EMPLOYEE'S employment by MAXWELL whether or not during regular working hours and regardless of where such inventions, discoveries, improvements, trade secrets and secret processes are made or conceived. Any such disclosures will be received in confidence.

(d) That, except as provided by the following sentence of this subparagraph (d), he will, and does hereby assign and grant to MAXWELL all of his right, title and interest in and to the inventions, discoveries, improvements, trade secrets and secret processes described in subparagraph (c) above and any patents granted thereon, and at the request and expense of MAXWELL he will make, execute and deliver all application papers, assignments or instruments and perform or cause to be performed such other lawful acts as MAXWELL may deem desirable or necessary in making or prosecuting applications, domestic or foreign, for patents, re-issues, and extensions thereof, and assist and cooperate (without expense to him) with MAXWELL or any of its designated representatives, in any controversy or legal proceedings relating to said inventions, discoveries, improvements, trade secrets and secret processes or to any patents which may be procured thereon. EMPLOYEE shall not be required pursuant to this subparagraph (d) to assign or to offer to assign any of his

right, title or interest in or to any inventions, discoveries, improvements, trade secrets or secret processes which qualify fully under the provisions of Section 2870 of the California Labor Code, which provides as follows:

Any provision in an employment agreement which provides that an employee shall assign or offer to assign any of his or her rights in an invention to his or her employer shall not apply to an invention for which no equipment, supplies, facility, or trade secret information of the employer was used and which was developed entirely on the employee's own time, and (a) which does not relate (1) to the business of the employer or (2) to the employer's actual or demonstrably anticipated research or development, or (b) which does not result from any work performed by the employee for the employer. Any provision which purports to apply to such an invention is to that extent against the public policy of this state and is to that extent void and unenforceable.

(e) That should EMPLOYEE be requested after termination of his employment to perform services for MAXWELL in connection with any inventions, discoveries, improvements, trade secrets or secret processes required to be assigned to MAXWELL pursuant to subparagraph (d) hereof, he shall be paid therefor the same rate prevailing at the time of termination.

(f) That all inventions, discoveries, improvements, trade secrets and secret processes required to be assigned to MAXWELL pursuant to subparagraph (d) hereof, whether or not patented, shall become and remain the property of MAXWELL, its



successors and assigns unless expressly released by MAXWELL as hereinafter provided.

(g) That upon request or at the time of leaving the employ of MAXWELL he will deliver to MAXWELL and not keep or deliver to anyone else, any and all drawings, blueprints, notes, memoranda, specifications, devices, documents and in general any and all material provided by MAXWELL to EMPLOYEE or related to MAXWELL'S business or activity or to any inventions, discoveries, improvements, trade secrets or secret processes with the exception of any drawings, blueprints, notes, memoranda, specifications, devices, documents or material prepared by EMPLOYEE in connection with any inventions, discoveries, improvements, trade secrets or secret processes which are not required pursuant to subparagraph (d) hereof to be assigned to MAXWELL.

2. MAXWELL will investigate each disclosure submitted by EMPLOYEE and, if it elects to file a patent application with respect to any inventions, discoveries, improvements, trade secrets or secret processes required to be assigned to MAXWELL pursuant to subparagraph (d) of paragraph 1 hereof, agrees to pay all expenses in connection with the preparation and prosecution of such patent application or applications which it may decide to file in the United States of America or in foreign countries.

3. If EMPLOYEE petitions MAXWELL in writing to release any of its rights to any inventions, discoveries, improvements,

trade secrets or secret processes or any patents granted thereon, which are required to be assigned to MAXWELL pursuant to subparagraph (d) of paragraph 1 hereof, the latter will promptly consider and act on such petition but is not obligated to release any of its rights to EMPLOYEE.

4. EMPLOYEE warrants that the attached Exhibit A has been signed by him and comprises a complete description of all inventions, discoveries, improvements, trade secrets and secret processes, including any patents and patent applications thereon, which he made, invented or conceived prior to entering the employ of MAXWELL, to which he now claims title and which are to be specifically excluded from this Agreement.

5. This Agreement shall be binding upon and inure to the benefit of MAXWELL and EMPLOYEE, as well as their respective heirs, executors, administrators, successors, and assigns. For purposes of this Agreement, the term "MAXWELL" shall be deemed to include MAXWELL LABORATORIES, INC. as well as all of its currently existing or hereafter acquired or formed subsidiaries and affiliates.

6. This Agreement constitutes the entire agreement between MAXWELL and EMPLOYEE with respect to the subject matter hereof and this Agreement supersedes and replaces any prior agreement or understanding entered into between MAXWELL and EMPLOYEE. This agreement shall become effective and binding retroactively to the earliest date of employment of EMPLOYEE by MAXWELL. This

Agreement shall be governed by the laws of the State of California. The masculine gender shall be deemed to include the feminine gender.

DATED 8/20/84

MAXWELL LABORATORIES, INC.

By Betty Ross

\_\_\_\_\_  
  
\_\_\_\_\_

Joseph A. Mann, Pres.  
EMPLOYEE

EXHIBIT A ATTACHED:

Yes ( )

No ☒

10039311-102601

Practitioner's Docket No. 62891

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Clark, et al.

For: PARAMETRIC CONTROL IN PULSED LIGHT STERILIZATION

the specification of which:

(check and complete (a), (b), or (c))

- (a) ☐ is attached hereto.
- (b) ☒ was filed on 6/4/99, as Application Serial No. 09/326,168  
and was amended on \_\_\_\_\_ (if applicable).
- (c) ☐ was described and claimed in International Application No. \_\_\_\_\_,  
filed on \_\_\_\_\_ and as amended on \_\_\_\_\_ (if any).

**STATEMENT OF FACTS IN SUPPORT OF FILING  
ON BEHALF OF NONSIGNING INVENTOR (37 C.F.R. § 1.47)**

**NOTE:** This statement as to the pertinent facts concerning the refusal of the nonsigning inventor to join in the application or where the omitted inventor cannot be found or reached must accompany the declaration signed on behalf of the omitted inventor by a joint inventor or by a legal representative who shows a proprietary interest. Where the entity with a proprietary interest executes the declaration on behalf of the omitted inventor there must also be a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. 37 C.F.R. §§ 1.47(a) and (b).

This statement is made as to the exact facts that are relied upon to establish the diligent effort made to secure the execution of the declaration by the nonsigning inventor for the above-identified patent application before deposit thereof in the Patent and Trademark Office.

(check next item, if applicable)

- ☐ Because signing on behalf of the nonsigning inventor is by a person or entity showing a sufficient proprietary interest, this statement also recites facts as to why this action was necessary to preserve the rights of the parties or to prevent irreparable damage.

This statement is being made by the available person having first-hand knowledge of the facts recited therein.

**NOTE:** The statement "must be signed, where at all possible, by a person having first-hand knowledge of the facts recited therein." M.P.E.P. § 409.03(d), 7th ed. If different persons have first-hand knowledge of different facts, then a declaration from each such person as to those facts he or she knows should be submitted separately.

**NOTE:** Copies of documentary evidence, such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions. M.P.E.P. § 409.03(d), 7th ed.

**IDENTIFICATION OF PERSON MAKING THIS STATEMENT OF FACTS**

Carrie Merzbacher  
Name  
4250 Executive Square, Ste. 510  
Address  
La Jolla, CA 92037

FOOT FOOT FOOT

**EFFORTS DURING CONVENTION YEAR TO PREPARE APPLICATION AND  
OBTAIN INVENTOR'S SIGNATURE**

**NOTE:** *In cases where priority under 35 U.S.C. § 119 is to be claimed, the 37 C.F.R. § 1.47 applicant should explain what efforts, if any, were made during the Convention year to prepare the application and obtain the inventor's signature thereon. The period allowed by the Convention year should "be sufficient for the preparation and deposit of an application . . . in the form required by the rules." . . . Accordingly, 37 C.F.R. § 1.47 may not be used "to save the parties from the consequences of their delay." M.P.E.P. § 409.03(d), 7th ed.*

N/A

*(use Supplemental Page(s), if necessary)*

10039311-102601

## LAST KNOWN ADDRESS OF THE NONSIGNING INVENTOR

*NOTE: The last known address of the nonsigning inventor must be stated so that the PTO can forward the notice of filing of the application to the nonsigning inventor at said address. (37 C.F.R. § 1.47). A post office box is insufficient. M.P.E.P. § 409.03(e), 6th ed.*

Joseph E. Dunn

---

Full name of nonsigning inventor

7108 Red Barn Road

---

Last known address of nonsigning inventor

Crystal Lake, IL 60012

---

*NOTE: Ordinarily, the last known address will be the last known residence of the nonsigning inventor, but other addresses at which the nonsigning inventor may be reached should also be given in the space below. M.P.E.P. § 409.03(e), 6th ed.*

10039311-102501  
"TE5E001"

## DETAILS OF EFFORTS TO REACH NONSIGNING INVENTOR

**NOTE:** Complete either these facts or the facts as to REFUSAL OF NONSIGNING INVENTOR TO SIGN APPLICATION PAPERS.

**NOTE:** In addition to a recitation of these efforts, which must have been made before the application was deposited in PTO, copies of documentary evidence such as letters, telegrams, responses, etc. that support a finding that a nonsigning inventor could not be found or reached should, if available, be made part of the declaration. It is important that the affidavit or declaration contain statements of fact as opposed to M.P.E.P. § 409.03(d), 7th ed. conclusions.

N/A

(use Supplemental Page(s), if necessary)

1003934.102601



**DETAILS OF REFUSAL OF NONSIGNING INVENTOR  
TO SIGN APPLICATION PAPERS**

**NOTE:** Complete either these facts or the facts as to DETAILS OF EFFORTS TO REACH NONSIGNING INVENTOR.

**NOTE:** The circumstances of this refusal must be specified by the person to whom the refusal was made and, before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings and declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The time and place of an oral refusal should be stated, or a copy of the written refusal should be attached.

*If it is the conduct as a whole of the nonsigning inventor that is the refusal, then all the facts upon which this conclusion is based should be stated and a copy of any documentary evidence supporting these facts should be attached.*

*Where there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.*

*Whenever the nonsigning inventor gives a reason for refusing to sign the application papers, that reason should be stated. M.P.E.P. § 409.03(d), 7th ed.*

On August 12, 1999 I telephoned Dr. Joseph Dunn at his residence in Illinois requesting his cooperation in executing an Assignment of Rights and Declaration/Power of Attorney relative to the subject patent application. Dr. Dunn informed me that he would be cooperative and to go ahead and forward the documents requiring execution to his home residence of 7108 Red Bard Road, Crystal Lake IL 60012,

On August 13, 1999, I forwarded the subject documents to Dr. Dunn via first class mail.

In a followup telephone conversation with Dr. Dunn a couple of weeks later inquiring into the disposition of the documents, he informed me that he had changed his mind and had no intention of signing any documents relative to this matter and associated with PurePulse Technologies, Inc. This telephone call was placed to Dr. Dunn's office number (815) 338-9500, Ext. 216 on September 3, 1999 at 1:03 p.m.

(use Supplemental Page(s), if necessary)

**PROOF OF NEED TO PREVENT IRREPARABLE DAMAGE  
OR PRESERVE THE RIGHTS OF THE PARTIES**

**NOTE:** *This proof must be presented where the declaration is signed by a person with sufficient proprietary interest for the nonsigning inventor (37 C.F.R. § 1.47(b)), but is not a requirement when the person signing for the nonsigning inventor is a joint inventor. (37 C.F.R. § 1.47(a)).*

*If a statutory bar is involved, the act or publication which is believed to constitute the bar should be identified. If a claim for priority is involved, the prior application or applications should be identified.*

*A diligent effort to prepare the application and obtain the inventor's signature thereon must be made, even if the application is being filed to avoid a bar or to claim priority. M.P.E.P. § 409.03(g), 7th ed.*

*Irreparable damage may be established by showing that a filing date is necessary to (1) avoid a statutory bar or (2) make a claim for priority, which should identify the prior application(s) involved.*

*Preservation of the rights of the parties may be demonstrated by a showing that the nonsigning inventor may reasonably be expected to enter into competition with the person having a proprietary interest and signing on behalf of the nonsigning inventor or that a firm plan for commercialization of the subject matter of the application has been adopted.*

*M.P.E.P. § 409.03(g), 7th ed.*

N/A

*(if this proof is not needed and not being presented,  
then draw a line through this page of the form.)*

*(use Supplemental Page(s), if necessary)*

Date: November 8, 1999

Signature of person making statement  
Carrie Merzbacher

☐ Plus \_\_\_\_\_ Added Page(s)

(Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor [1-6]—page 8 of 8)